REMARKS

I. Status of the Claims

Claims 36 and 38-44 are pending. Claim 26 is amended herein to incorporate the limitations of claim 37. Accordingly, claim 37 is cancelled herein without prejudice or disclaimer. Claims 38 and 44 are amended herein to depend from claim 36. Support for the above amendments may be found in the originally filed specification and claims, for example, original claims 3 and 16. Thus, the above amendments introduce no issue of new matter.

Claims 36-44 stand rejected under 35 U.S.C. §103(a) as unpatentable over Japanese Patent Application No. JP 09-165681 ("Sagusa") in view of U.S. Patent No. 5,600,530 ("Smith") and U.S. Patent No. 6,120,661 ("Hirano"). Office Action, pages 2-6. Applicants respectfully disagree with and traverse the rejection for at least the reasons set forth in the below arguments.

II. Arguments

Claims 36-44 stand rejected under 35 U.S.C. §103(a) as unpatentable over Sagusa in view of Smith and Hirano. *Id.* Applicants respectfully disagree with and traverse this rejection for at least the following reasons.

The Examiner's rejection is predicated on the modification of Sagusa with the Electrode of Hirano. *Id.* at 6. Applicants submit, however, that Hirano is not valid prior art against the present application, as discussed below.

Applicants respectfully direct the Examiner to 35 U.S.C. §102(a) and (e), which state, *inter alia*:

> A person shall be entitled to a patent unless:
>
> (a) the invention was...described in a printed publication in this or a foreign country, ***before*** the invention thereof by the applicant for patent..." (emphasis added)
>
> (e) the invention was described in -
>
> (1) an application for patent, published under section 122(b), by another filed in the United States ***before*** the invention by the applicant for patent or
>
> (2) a patent granted on an application for patent by another filed in the United States ***before*** the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or

Applicants further direct the Examiner to the Declaration filed September 22, 2000, Applicant's Claim of Priority dated April 10, 2001, and the Preliminary Amendment dated April 6, 2001, wherein Applicants claim priority under 37 C.F.R. §§1.119 and 1.120 to International Application No. PCT/JP00/02228, filed April 6, 2000, and Japanese Patent Application No. 11-099353, filed April 6, 1999. In addition, Applicants direct the Examiner to Applicant's Submission of English Language Translation of Priority Document dated June 27, 2002, wherein Applicants perfected their priority claim by submitting an English Language translation of Japanese Patent Application No. 11-099353. Thus, the present application has a filing date of at least April 6, 1999.

U.S. Patent No. 6,120,661 to Hirano, however, has an effective filing date under 35 U.S.C. §102(e) of June 7, 1999, which is after the effective filing date of the present

application. Thus, Hirano ***is not available*** as prior art against the present application, because it does not satisfy the "before" requirement of 35 U.S.C. §102(a) or (e). Indeed, in the Office Action dated August 1, 2003, the Examiner, in Response to Applicant's prior arguments that Hirano is not available as prior art, stated:

> Applicant's arguments, see second paragraph, page 8, filed May 6, 2003, with respect to the rejection of claims 6, 8, 11, 16, 19, and 25 under Hirano et al. (USPat 6,120,661) have been fully considered and are persuasive. Office Action dated August 1, 2003, page 9, section 13.

Applicants are at a loss as to why the Examiner now considers Hirano to be valid prior art, when the Examiner expressly acknowledged that Hirano is ***not*** available as prior art against the present application in the Office Action dated August 1, 2003.

Regardless, Applicants submit that it is now clear that Hirano is not available as prior art against the present application. Thus, Applicants submit that the rejection of claims 36-44 under 35 U.S.C. §103(a) as unpatentable over Sagusa, Smith, and Hirano is improper, and should be withdrawn. Moreover, Applicants submit that should the Examiner choose to present a new grounds of rejection in a future Office Action, that Office Action should be made non-final, as the new grounds of rejection would be predicated from the Examiner's erroneous interpretation of the validity of Hirano as prior art, **not** Applicant's above amendment. *See* M.P.E.P. §706.07(a) (emphasis strongly added).

III. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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